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10/728,864	12/08/2003	David A. George	YOR920030319US1	1182

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EXAMINER

CHEEMA, UMAR

ART UNIT	PAPER NUMBER
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2144

MAIL DATE	DELIVERY MODE
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02/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/728,864

Applicant(s)

GEORGE ET AL.

Examiner

Umar Cheema

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is response to the Amendment filed on 23 November 2007. Claims 1-30 are pending with claims 1, 14, 19, 24-25, 27 and 30 being independent claims. Claim 30 has been amended.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 19-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims read signal-bearing medium, which is directed to non-statutory subject matter and is unpatentable.

Claims 14-18 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter. The claims read dialog with a web server, which is directed to non-statutory subject matter (software, per se) and is unpatentable.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Jawahar et al. (Jawahar) (US Patent # 6,298,356).

Regarding claim 1, Jawahar discloses a method of enhancing a dialog with a web server, (see abstract; method and apparatus, col. 3, lines 52-54; monitoring an individual's access to information contained in a web server) said method comprising: determining a dialog state by comprehensively capturing a dialog with said web server (see col. 3, lines 59-67).

Regarding claim 2, Jawahar discloses the method of claim 1, further comprising: modifying said dialog, as based on said determining said state (see col. 8, lines 20-25).

Regarding claim 3, Jawahar discloses the method of claim 1, said determining a dialog state further comprising: analyzing a content of said dialog (see col. 8, lines 14-20).

Regarding claim 4, Jawahar discloses the method of claim 3, said determining a dialog state further comprising: analyzing a context of said content (see col. 8, lines 20-25).

Regarding claim 5, Jawahar discloses the method of claim 4, wherein said context analyzing optionally comprises natural language processing (see col. 8, lines 8-15, 20-25).

Regarding claim 6, Jawahar discloses the method of claim 1, wherein said comprehensively capturing said dialog comprises: causing an inbound request from said browser to be directed to an intermediary (see col.4, lines 10-16); and causing an outbound response bound for said browser to be first directed to said intermediary (see col. 4, lines 10-16).

Regarding claim 7, Jawahar discloses the method of claim 6, wherein said causing said inbound request and said outbound response to be directed to said intermediary further causes a plurality of inbound requests and a plurality of outbound responses to be directed to said intermediary (see col. 4, lines 10-16).

Regarding claim 8, Jawahar discloses the method of claim 1, further comprising: modifying a content of said dialog (see col. 8, lines 14-20).

Regarding claim 9, Jawahar discloses the method of claim 8, wherein said modifying comprises at least one of: modifying an existing element from one of an inbound request and an outbound response (see col. 4, lines 10-16, col. 13, lines 35-40); removing an element from said outbound response, wherein an action at said browser allows said element to be re-instated (see col. 4, lines 10-16, col. 13, lines 48-53); removing an element from said outbound response, wherein said removed element cannot be re-instated by any action at said browser (see col. 16, lines 16-22);

replacing a first element from one of said inbound request and said outbound response by a second element (see col. 6, lines 5-12); and
adding a new element to one of said inbound request and said outbound response (see col. 8, lines 20-25).

Regarding claim 10, Jawahar discloses the method of claim 9, wherein said modification comprises inserting a uniform resource locator (URL) to allow one of (see col. 11, lines 62-67, col. 12, lines 1-3):

said user to select a second, non-related web server; an inbound request for said user to be sent to a new target web server; an inbound request from said user to be directed to said web site and a response thereof to be sent to said intermediary (see col. 10 lines 60-67, col. 11, lines 1-3);

an outbound response from said web site to be directed to said user; and

an outbound response from one of said second non-related web server and said new target web server to be directed to said intermediary (see col. 4, lines 10-16, col. 10, 60-67).

Regarding claim 11, the limitations of this claim has already been addressed (see claim 10 above).

Regarding claim 12, Jawahar discloses the method of claim 2, wherein said modifying performs at least one of: improving an efficiency of said web site; censoring information

to said user; providing a warning to said user; asking said user to explain at least one of an action and a mental state (see col. 13, lines 29-35); providing additional information; providing additional information that can be selected by said user; indicating a second, non-related web site to be selectable by said user; and providing additional information to attempt to influence a decision by said user (see col. 13, lines 35-43).

Regarding claim 13, Jawahar discloses the method of claim 1, wherein said dialog continues to be captured when a user selects another web site (see col. 9, lines 36-11).

Regarding claim 14, the limitations of this claim has already been addressed except it is an apparatus (see claim 1 above, reference teaches both method and apparatus; see abstract).

Regarding claim 15, the limitations of this claim has already been addressed (see claims 3 and 4 above).

Regarding claim 16, the limitations of this claim has already been addressed (see claim 2 above).

Regarding claim 17, the limitations of this claim has already been addressed (see claim 2 above).

Regarding claim 18, the limitations of this claim has already been addressed (see claim 13 above).

Regarding claim 19, Jawahar discloses a signal-bearing medium tangibly embodying a program of machine-readable instructions executable by a digital processing (see col. 24, lines 16-20; computer readable medium) apparatus to perform a method of enhancing a dialog with a web server (see col. 3, lines 52-54; monitoring an individual's access to information contained in a web server), said method comprising: comprehensively capturing a dialog between said web server and a browser (see col. 3, lines 59-67).

Regarding claim 20, the limitations of this claim has already been addressed (see claims 3 and 4 above).

Regarding claim 21, the limitations of this claim has already been addressed (see claim 2 above).

Regarding claim 22, the limitations of this claim has already been addressed (see claim 2 above).

Regarding claim 23, the limitations of this claim has already been addressed (see claim 4 above).

Regarding claim 24, Jawahar discloses a method of providing a service, said method comprising at least one of:

operating an intermediary web service to comprehensively capture a dialog with a web site (see col. 3, lines 52-54), wherein said dialog is captured when an initial access request from a browser is received by said web site and a subsequent dialog between said web site and said browser is directed through said intermediary web service (see col. 3, lines 59-67, col. 8, lines 8-20);

operating a web site that requests said intermediary web service to capture said dialog (see col. 3, lines 52-54); analyzing information in said dialog; modifying a content of said dialog; designing a computer program module to be incorporated in said intermediary web service for said dialog capturing (see col. 24, lines 16-20); designing a computer program module to be used in said analyzing; and designing a computer program module to be used in said modifying content of said dialog (see col. 8, lines 14-20, lines 20-25).

Regarding claim 25, the limitations of this claim has already been addressed (see claim 6 and 7 above).

Regarding claim 26, the limitations of this claim has already been addressed (see claims 2).

Regarding claim 27, Jawahar discloses a method of providing a service, said method comprising at least one of: operating a web server so that, upon receiving an initial access request to said web server, a subsequent dialog associated with said initial access is directed through an intermediary established to capture said dialog (see col. 3, lines 59-67, col. 8, lines 8-20); operating a web server in the manner of said intermediary; at least one of developing, producing, selling, transmitting via said web server, and receiving, via a network, a set of machine-readable instructions executable by a digital processing apparatus to perform a method of capturing a dialog on said network using said intermediary (see col. 4, lines 54-60, col. 5, lines 46-60); at least one of developing, producing, selling, transmitting via said network, and receiving via said network a set of machine-readable instructions executable by a digital processing apparatus to perform a method of at least one of filtering and modifying a dialog being processed through said intermediary (see col. 8, lines 20-25); at least one of receiving, displaying, storing, analyzing, and receiving an analysis of a dialog captured using said intermediary (see col. 8, lines 14-20); at least one of developing, producing, selling, transmitting via said network, receiving via said network, and executing a set of machine-readable instructions executable by a digital processing apparatus to at least one of receive, display, store, and analyze a dialog captured using said intermediary (see col. 8, lines 14-20).

Regarding claim 28, Jawahar discloses the method of claim 27, wherein said capturing a dialog provides a method for at least one of: evaluating a website comprising said web

server; improving an efficiency of said website; determining a state of said user; influencing at least one of an action and a selection made by said user; and conducting an interview with said user (see col. 8, lines 20-25).

Regarding claim 29, Jawahar discloses a method for deploying computing infrastructure, comprising integrating computer-readable code into a computing system, wherein the code in combination with the computing system is capable of performing the method of claim 1 (see col. 24, lines 16-20; computer readable medium).

Regarding claim 30, Jawahar discloses a method of enhancing a dialog with a web server, said method comprising: comprehensively capturing a dialog with said web server (see abstract; method and apparatus, col. 3, lines 52-54; monitoring an individual's access to information contained in a web server) by: setting up an intermediary when a user contacts said web server (see figure 1, see col.4, lines 10-16); modifying URLs sent by said user so as to route requests of said user to said intermediary (see figure 5, col. 11, lines 62-67, col. 12, lines 1-3); and modifying URLs sent by said web server so as to route to said intermediary the responses of said web server to said requests, said intermediary thereby capturing all requests and responses of said dialog (see figure 4, col. 10 lines 60-67, col. 11, lines 1-3).

Response to Arguments

4. Applicant's arguments filed on 23 November 2007 have been fully considered but they are not persuasive. However, because there exists the likelihood of future presentation of this argument, the Examiner thinks that it is prudent to address applicant's main point of contention. Applicant's arguments includes:

- a. Regarding to claims 14-23 and 19-23, applicant argues that claims are not directed to non-statutory subject matter.
- b. Regarding to claim1, applicant argues that Jawahar does not teach or suggest "...determining a dialog state by comprehensively capturing a dialog with said web server".
- c. Regarding to claims 3-5 and 6-7, applicant argues that Jawahar fails to teach or suggest the plain meaning of the claims language of these claims and claims 25-26 Jawahar fails to reasonably teach or suggest using a method having the means described in the present application or any reasonable equivalent.

As for Point A, it is the Examiner's position that 35 U.S.C 101 rejection to Claims 14-23 and 19-23 is persuasive and therefore the claims are still rejected under 35 U.S.C 101 rejection. Claims 14-23 are directed to an "apparatus" does not make them statutory because according to the specification the apparatus can be a software. Claims 19-23 are directed to signal-bearing and signal can not be statutory. Thus it is Examiners position that the 35 U.S.C 101 rejection is proper.

Software, per se:

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

As for Point B, it is the Examiner's position that Jawahar does teach or suggest wherein said determining a dialog state by comprehensively capturing a dialog with said web server (see see col. 3, lines 52-67; a system in which an agent or other representative is able to communicated with a customer or other individual or system). Thus it is Examiners position that the claim elements are taught or suggest by Jawahar. Therefore 35 U.S.C 102 (b) rejection is proper.

As for Point C, it is the Examiner's position that Jawahar teaches or suggests the claims 3-5 and 6-7 and 25-26 for the given reason above (see claims rejection). Thus it is Examiners position that 35 U.S.C 102 (b) rejection is proper.

5. Examiner's Note: Examiner has cited particular paragraphs, figures, columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Umar Cheema whose telephone number is 571-270-3037. The examiner can normally be reached on M-F 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn, Jr. can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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